

### REMARKS

1           The Examiner objected to the drawings under 37 C.F.R. 1.83(a) for the reason  
that at least one of the plurality of teeth is not shown on both sides of the lower jaw, as  
initially claimed in claim 5. Claim 5 has been cancelled. Applicant now believes the  
5       drawings to be in condition for allowance.

          The Examiner rejected claims 1-12 under 35 USC §102(b) as being anticipated  
by U.S. Patent No. 3,482,614 (Jordan) or U.S. Patent No. 3,550,655 (Murphy).  
Applicant respectfully disagrees with the Examiner's rejections. However, in an effort to  
expedite the present application, claims 2, 3, 5, 11 and 12 have been cancelled. More  
10       importantly, claim 1 has been amended to specifically include the limitations that: a) the  
lower jaw is comprised of first and second side members that are laterally spaced from  
one another to define an opening in the upper edge portion of the lower jaw that is  
shaped and sized to receive at least a portion of the cutting edge of the upper jaw when  
15       the shear is in said closed position; and b) the at least one tooth extends generally  
upwardly from only one of the first side member or the second side member of the lower  
jaw. The prior art fails to teach or otherwise suggest any such structural arrangement.

          The aforementioned structural arrangement provides a significant advantage over  
prior art shears. Figure 3 depicts the shear in a generally horizontal position. The teeth  
20       36 are coupled with only the first side member 18 of the lower jaw 14. In the  
embodiment depicted, the first side member 18 is positioned below the second side  
member 20 and the upper jaw 12, when it moves to its closed position. After a review of  
the Detailed Description and Figure 3, the significant advantage will become apparent to  
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1 those of skill in the art. The scissoring action of the upper jaw 12 over the teeth 36 will  
tend to push the tree being cut slightly in the direction of the path that the upper jaw 12  
moves, both away from the at least one actuator and in a definite direction. Without the  
teeth 36, or when teeth 36 are positioned on both the first and second side members 18  
and 20, the cut portion of the tree will fall in a less predictable direction since the  
direction will become more heavily dependant on sheer angle, shape and mass-  
dispersal of the tree, pitch of the operating surface, etc. Not only will the forced felling  
of the tree in the direction of blade travel help protect components of the shear, it will  
greatly increase the safety of individuals and property around the tree being felled.  
Accordingly, claim 1 is believed to be patentably distinct from the prior art. Claims 4  
and 6-10 each ultimately depend from amended claim 1 and are believed to be  
allowable for at least the reasons set forth herein with respect to claim 1.

The Examiner rejected claims 1-12 under 35 USC §103(a) as being unpatentable  
over either Jordan or Murphy in further view of U.S. Patent No. 4,908,946 (Labounty).  
Specifically, the Examiner states that the Labounty device has each of the structural  
limitations set forth within claims 1-12 except the one or more teeth along the lower jaw.  
The Examiner states that, based on the Jordan or Murphy Patents, it would have been  
obvious to a person having ordinary skill in the art to provide the Labounty device with  
one or more teeth along the lower jaw. Applicant respectfully disagrees with the  
Examiner's rejections. However, as discussed in greater detail hereinabove, applicant  
has cancelled claims 2, 3, 5, 11 and 12 and amended claim 1. The amendments to

claim 1 are not suggested or otherwise disclosed anywhere in the prior art and are  
1 believed to render claim 1 allowable.

Obviousness can only be established by combining or modifying the teachings of  
the prior art to produce a claimed invention where there is some teaching, suggestion,  
5 or motivation to do so, found either explicitly or implicitly in the references themselves or  
in the knowledge generally available to one of ordinary skill in the art. "The test for an  
implicit showing is what the combined teachings, common knowledge of one of ordinary  
skill in the art, and the nature of the problem to be solved as a whole would have  
suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 55  
10 USQP2d 1313 (Fed. Cir. 2000). In the Kotzab case, the Federal Circuit decided that the  
control of multiple valves by a single sensor, rather than by multiple sensors, was a  
simple concept. However, the Federal Circuit held that there was no finding as to the  
specific understanding or principle within the knowledge of the skilled artisan that  
15 would have provided the motivation to use a single sensor as the system to control  
more than one valve. Id. Similarly, the applicant's improvement is a simple concept  
that only becomes apparent to those of skill in the art after a complete review of the  
applicant's specification and Figures.

The mere fact that the references can be modified does not render the resulting  
20 modified structure obvious unless the prior art also suggests the desirability of the  
combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). "A  
statement that modifications of the prior art meet the claimed invention and would have  
been 'well within the ordinary skill in the art at the time the claimed invention was made  
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1 because the references relied upon teach that all aspects of the claimed invention were  
individually known in the art' is not sufficient to establish a *prima facie* case of  
obviousness without some objective reason to combine the teachings of the  
references." Ex parte Leavengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).  
5 The combined teachings of the cited references do not provide a sufficient body of  
material to render the subject claims obvious to a person of ordinary skill in the art, even  
in view of the presumed knowledge held by such a person of skill in the art.

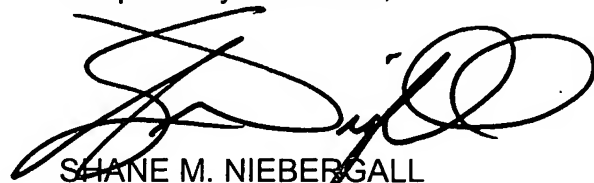
In determining the difference between the prior art and the claims, the question  
under 35 U.S.C. § 103 is not whether the differences themselves would have been  
10 obvious, but whether the claimed invention as a whole would have been obvious.  
Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). A  
prior art reference and the claimed invention must be considered in their entireties.  
Distilling an invention down the "gist" or "thrust" of an invention disregards the  
15 requirement of analyzing the subject matter "as a whole." W.L. Gore & Associates, Inc.  
v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *Cert. denied*, 469 U.S.  
851 (1984).

New claim 13 has been added, which claims the method of using the combination  
of claim 8 to fell a tree. Claim 13 is believed to be allowable for numerous reasons,  
20 some of which include its dependence on claims 8 and 1. Another reason for claim 13's  
allowability is base in the limitation that the shear is positioned to be generally horizontal  
and so that the "upper jaw may be moved to said closed position in a right-to-left  
manner". This may seem trivial at first blush. However, the prior art fails to show a  
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1 tree-felling device in this particular configuration. The configuration is important, in part,  
then the system is used (according to the method claimed) in the Northern Hemisphere,  
due to the Coriolis Effect. The Coriolis Effect alters the paths of moving objects on  
Earth. Everything from jets to ships to bowling balls and even trees being felled are  
5 affected, even if ever so slightly, by the Coriolis Effect. With the teeth positioned on the  
lower jaw and the upper jaw moving from right to left in a generally horizontal position,  
the tree will experience a slight counterclockwise rotational effect from. This will be  
aparent to those of skill in the art upon a review of the Figures and the specification.  
Accordingly, the claimed structural arrangement and use are able to use the slight  
10 forces of the Coriolis Effect in felling the tree. Accordingly, the Examiner is respectfully  
requested to consider claim 13 and allow the same.

No fees or extensions of time are believed to be due in connection with this  
amendment; however, please consider this a request for any extension inadvertently  
15 omitted, and charge any additional fees to Deposit Account No. 502093.

Respectfully submitted,




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CERTIFICATE OF MAILING

I hereby certify that the original of this AMENDMENT for WARREN D. GREGORY, JR., Serial No. 10/774,740, was mailed by first class mail, postage prepaid, to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 9<sup>th</sup> day of November, 2005.

  
SHANE M. NIEBERGALL